

REMARKS

Claims 53-79 are pending in this application.

In item 5 of the Final Office Action, the Office rejected claims 53-55, 57-74, and 76-79 under 35 U.S.C. § 112, first paragraph, because it asserted that the claim term "at least one cPPT sequence and at least one CTS sequence, wherein any other sequence of pol, other than the 178 bp fragment comprising the cPPT and CTS sequence is absent" does not limit the claim to the 178 bp fragment comprising cPPT and CTS, which, according to the Office, is supported by the specification. See Office Action of February 26, 2004, at 3. In making this rejection, the Office asserted:

[T]he specification does not provide explicit support for a nucleic acid comprising only the cPPT and CTS sequences of pol and no other sequence of pol. Additionally, the specification does not have implicit basis for a nucleic acid comprising at least one cPPT sequence and at least one CTS sequence wherein there is no other sequence of pol present, because the specification only discloses a 178 bp fragment of pol comprising a cPPT and a CTS sequence.

Id.

In addition, in item 6, the Office rejected claims 53-55, 57-74, and 76-79 under 35 U.S.C. § 112, first paragraph, because it asserted that these claims are not enabled by the specification by not including the allegedly critical element of the 178 bp fragment comprising the cPPT and CTS sequences. The Office supported this rejection by stating that "there is no disclosure indicating that anything less than the 178 bp fragment can confer the desired function (the ability to form triplex structure) to a nucleic acid sequence." *Id.* at 5.

Applicants thank the Office for the suggested amendments of claims 53, 65, 71, 76, 78, and 79 to overcome these rejections, but have chosen to amend the claims in a

slightly different way. Specifically, Applicants have amended these claims to recite that the retroviral nucleic acid consists of “at least one cPPT sequence, at least one CTS sequence, and the intervening *pol* sequences.” Because of the term “consisting of”, the claim as amended has the same limits as that proposed by the Office.

The Office acknowledged that the specification does support the intervening *pol* sequences present between cPPT and CTS. See *id.* at 3 (“This statement clearly indicates that a 178 bp PCR fragment comprising both the cPPT sequence and CTS sequence, as well as the intervening *pol* sequence is present in the vector.”) Therefore, Applicants respectfully assert that a written description of the invention as claimed is provided in the specification and that it is enabled by the specification. Accordingly, Applicants respectfully request that both rejections under 35 U.S.C. § 112, first paragraph be withdrawn.

In item 9, the Office rejected claim 75 under 35 U.S.C. § 102(b) in light of Zuffrey et al. The Office asserted that Zuffrey et al. teach an HIV-1 based vector having a nucleic acid comprising the elements of the claimed nucleic acid and therefore anticipate it. Applicants traverse this rejection. Although the Office asserted that all of the elements of the claimed nucleic acid are disclosed, the claimed nucleic acid includes an EF1 α promoter, which is not disclosed by Zuffrey et al. In fact, the Office explained that Zuffrey et al. disclose a CMV promoter in Figure 3 on page 873. In contrast, the specification describes that an *EcoRI/BamHI* fragment was used to replace the CMV promoter present in the precursor plasmid with an EF1 α promoter. See specification at page 32, lines 15-18. The EF1 α promoter is, therefore, part of the TRIP EF1 α Δ U3 GFP plasmid from which the claimed nucleic acid is derived. Because

Zuffrey et al. do not disclose each and every element of the nucleic acid recited in claim 75, for example, an EF1 α promoter, Applicants respectfully request that this rejection be withdrawn. See *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

In item 10, the Office objected to claim 56 as being dependent on a rejected claim. Merely to further prosecution, Applicants have amended claim 56 to be an independent claim. Thus, Applicants respectfully request that the objection be withdrawn.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 53-79 in condition for allowance. Applicants submit that the proposed amendments of claims 53, 65, 71, 76, 78, and 79 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

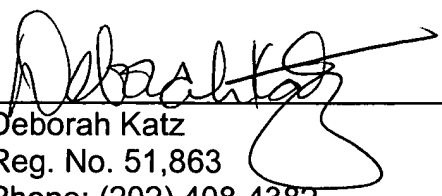
Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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